

REMARKS

In response to the Office Action dated July 26, 2005, the Applicant has amended claims 1, 6, 9, 14, and 17. Claims 1-20 remain in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-20 under 35 U.S.C. 112, first paragraph, as allegedly based on a disclosure that is not enabling.

In particular, the Examiner stated that "[C]ommon sense dictates that enablement requires an explanation of how Applicant makes such a determination, not merely a statement that such a determination is being made." In addition, the Examiner stated that "...Applicant argues that one cannot use common sense in evaluating issues concerning patentability, yet sets forth no case law to support such a position. It's a safe bet no tribunal has ever espoused the elimination of common sense in the analysis of legal issues." (see pages 5 and 19 of the Office Action).

First, the Applicant reiterates that the Examiner is prohibited from using his "common sense" only, when rejecting the claims for non-enablement. While the Applicant does not argue that the Examiner's basic "common sense" is worthless, the Applicant submits that more than the Examiner's "common sense" is required to reject the claims for non-enablement. If Examiners were not required to prove non-enablement with a rational and well supported basis, but were allowed to merely make unsupported statements based solely on "common sense", they would have way too much discretion when rejecting the claims for non-enablement. **Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.**, 228 F3d 1338, 56 USPQ 1332, 1136 (Fed. Cir 2000), *cert. denied*, 532 U.S. 1019 (2001).

Namely, it is well settled that in order for an Examiner to maintain a prima facie case of non-enablement, the Examiner must provide the following: a rational basis as to why the disclosure does not teach or why to doubt the objective truth of the statements in the disclosure that purport to teach; the manner and process of making and using the invention that corresponds to the scope of the claims to one of ordinary skill in the art requires undue experimentation; **and** it deals with subject matter that would not already be known to the skilled person as of the filing date of the application. Unquestionably, a conclusory statement supported merely by the Examiner's "common sense" clearly is not enough to satisfy the Examiner's burden of proof. Thus, the rejection is not proper under Section 112, first paragraph. **Enzo Biochem, Inc. v. Calgene, Inc.**, 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999).

In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993).

Next, the statement by the Examiner that "...Applicant argues that one cannot use common sense...yet sets forth no case law..." implies that an initial burden exists on the Applicant when an Examiner rejects any claim based on non-enablement. However, contrary to the Examiner's statements, the CCPA has clearly stated that the "PTO has the burden of giving reasons, supported by the record as a whole, why the specification is not enabling... Showing that the disclosure entails undue experimentation is part of the PTO's initial burden..." In re Angstadt, 190 USPQ 214, 219 (C.C.P.A. 1976). Although the Examiner attempted to bypass this requirement by stating that "common sense dictates that enablement requires an explanation of how Applicant makes such a determination, not merely a statement that such a determination is being made", the Applicant submits that the Examiner is not permitted to do so. As such, the Examiner, not the Applicant, is required to provide case law to support his position if he actually decides to rely merely on his "common sense."

Moreover, the court in Staehelin v. Seher, 24 USPQ2d, 1513 (B.P.A.I. 1992) clearly stated that "[I]t has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement... How such a teaching is set forth, whether by use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims *must* be taken as complying with the first paragraph of 35 USC 112 *unless* there is a reason to doubt the objective truth of the statements relied upon there for enabling support. Id. At 1516 (citing In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (C.C.P.A. 1971)) (emphasis in original). As such, if the Examiner rejects the claims for non-enablement, the Examiner, and not the Applicant, has the initial burden of proof.

Further, the Fed. Circuit has clearly stated that patent applications are written for persons familiar with the relevant field; the patentee is not required to include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002).

Examiners can only reasonably doubt an invention's asserted utility if the

written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. In re Cortright, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999). Last, the court in Enzo Biochem, Inc. v. Calgene, Inc., 52 USPQ 2d 1129, 1135-36 (Fed. Cir. 1999) concluded that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, as long as the experimentation is not undue. As such, for the reasons as set forth above, the Applicant submits that the rejection should be withdrawn because the claims are enabling and comply with 35 U.S.C. 112, first paragraph.

Therefore, the above case law is clear: paragraphs [0015] through [0020] of US Publication No. 2003/0023631) with reference to Figs. 2-3 of the Applicant's disclosure (page 3, line 5 through page 4, line 3) is enabling with respect to the claims because it describes a typical web page with information content and determining unused available space on that page for placing the micro-advertisements in the unused available space.

In summary, since the Examiner has not set forth a reasonable explanation as to why he believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement, the rejection must be withdrawn. As argued above, the Examiner cannot use only his "common sense" because it is not supported by the case law. Instead, the Examiner has the initial burden of proof and must give a detailed explanation, which he has not, supported by the record as a whole, why the specification is not enabling, including a showing that the disclosure entails undue experimentation. In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993). In re Angstadt, 190 USPQ 214, 219 (C.C.P.A. 1976).

Claims 17-20 were rejected under 35 U.S.C. § 112, second paragraph, as having insufficient antecedent basis.

The Applicant has amended claim 17 to overcome this rejection.

Claims 1-11, 14-15 and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta et al. (U.S. Patent No. 6,487,538) in view of Markowitz et al. (U.S. Patent No. 6,311,185). Claims 12-13 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta et al. in view of Markowitz et al. and further in view of a Laura Lemay publication (SAM'S Teach

Yourself Web Publishing with HTML 4 in 21 Days, 2nd Edition, Sam's Publishing), hereinafter referred to as Lemay.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicant's independent claims have been amended to include selecting the micro-advertisement from a pool of micro-advertisements with the highest bid and debugging the micro-advertisement to make sure it is an appropriate advertisement targeted to the information content. Support for these amendments can be found at paragraphs [0018] and [0022] through [0024] and FIG. 3 of US Publication No. 2003/0023631).

The Applicant submits that the Gupta reference, alone or in combination with the Markowitz et al. reference do not disclose, teach, or suggest all of the claimed features of the amended claims. Although Gupta et al. disclose examining unused space and Markowitz et al. disclose adding a selected advertisement to an area that is blank or empty, Gupta et al. in combination with Markowitz et al. clearly do not disclose the Applicant's selecting the micro-advertisement from a pool of micro-advertisements with the highest bid and debugging the micro-advertisement to make sure it is an appropriate advertisement targeted to the information content.

Instead, Gupta et al. and Markowitz et al. explicitly discloses selecting advertisements from an advertising database based on history, profiles, and demographics. However, none of the cited references, in combination or alone, disclose selecting the micro-advertisement from a pool of micro-advertisements with the highest bid and debugging the micro-advertisement to make sure it is an appropriate advertisement targeted to the information content.

As such, since the cited references, when **combined**, are clearly missing at least one limitation of the Applicants' claimed invention, the combined references cannot be used to render the claims obvious. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

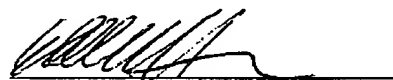
Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to

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withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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